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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/945,228	08/31/2001	Sanjay P. Godbole	BP907201	4550

7590

01/13/2003

BP America Inc.  
Docket Clerk, BP Legal, M.C. 2207A  
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Chicago, IL 60601-7125

EXAMINER

MANOHARAN, VIRGINIA

ART UNIT

PAPER NUMBER

1764

DATE MAILED: 01/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/945,228

Applicant(s)

GODBOLE, SANJAY P.

Examiner

Virginia Manoharan

Art Unit

1764

-- Th MAILING DATE of this communication appears on the cover sheet with th correspond nce address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 6-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 6-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

The Terminal Disclaimer filed on September 30, 2002 is PROPER and has been recorded.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claimed language "the feed stream to said heads column" recited in claim 10 lacks antecedent support since it is not initially recited in claim 1, the claim from which it depends.

Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The product recited in claim 13 can be made by many other ways than the process/method of claim 1. There is /are no further step(s) recited in claim 13 to further limit the process/method of claim 1.. See 608.01 (n) of the MPEP.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' Disclosure of Admitted Prior Art in view of Bitners et al (corresponding to FR '427) or Wu (3,885,928).

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It is noted at the outset that applicant use of Jepson format , is in effect, an implied admission by applicant that the process steps recited in the preamble were known in the art, leaving for consideration only whether the improvement clause imparts patentability to the claims . This implied admission is supported at page 3, lines 7-22 of the instant specification.

While not positively recited, obviously the formation of an aqueous phase above the feed tray is inhibited because the distillation column (corresponding to the claimed heads column) of Bitners operates in a manner as claimed e.g., in claim 6. That is, a side decanter is used to remove aqueous material from the column .See col. 4, lines 13-64. See also col. 1, lines 19-24 of Wu. It would have been obvious to one of ordinary skill in the art to incorporate Bitner's or Wu's process to the process admitted to be know especially since Bitner suggests at col. 5, lines 4-12 that "It was surprising and by no means predictable that in the separation of hydrocyanic acid from the mixture ... most of the water can be removed by way of decanting..."

Claim 13 recites a product limitation which would not serve as the basis for patentability of a method/process claim (claim 1).

Claims 1-2, 6, 9-10 and 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Disclosure of Admitted Prior Art in view of EP 0024788 and GB 2041372.

Applicant's admission is discussed supra. EP '788 operates such that the column is operated under reduced pressure to decrease polymer formation.

See page 2, lines 2-3 and the EXAMPLE at pages 10-11. See also the intermediate condenser (10) of GB '372 for claim 9.

GB '372 further suggests at page 2, lines 114-121, the method of claim 2.

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It would have been obvious to one of ordinary skill in the art to incorporate EP '788 and GB '372 processes to the process admitted to be known by applicant inasmuch as EP '788 suggests at page 2, lines 11-14, "...the need for a column to remove water ... for purifying the acrylonitrile ...", and inasmuch as GB '372 suggests "... a small reflux ratio in ..condenser ... becomes larger and accordingly, hydrogen cyanide is not enriched ..."

Furthermore, the concept of cooling a feedstream as claimed in claim 10 is rendered obvious at page 5, lines 32-35 of EP '788. Likewise, claim 6 is shown in Fig. 3 and at page 7, lines 26-29.

The intermediate condenses 158 in Fig. 2 of EP '788 also rendered obvious the method of claim 9.

Claims 1, 7-8 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Disclosure of Admitted Prior Art in view of EP 0053578.

Applicant's admission is discussed above.

The process of increasing the number of tray as claimed in claim 7 is within the purview of one skilled in the art as suggested at page 3, lines 1-2 from the bottom of the EP '578 reference. See also EP '578 suggestion at page 6, lines 9-11 for claim 8.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 13 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over anyone of Bitners et al, EP '788, EP '678 or GB '372.

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Obviously any one of the above references obtains acrylonitrile, methacrylonitrile or hydrogen cyanide since each of the references would inhibit the formation of an aqueous phase above the feed tray since they perform the same methods as claimed as discussed above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Virginia Manoharan whose telephone number is 703-308-3844. The examiner can normally be reached on Tuesday-Friday from 7:30 am to 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 703-308-6824. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9462 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

V. Manoharan/mn  
January 12, 2003

*Virginia Manoharan*  
SEARCHED  
SERIALIZED  
INDEXED  
1/12/03